

REMARKS

In the outstanding Final Office Action (hereinafter, "OA") mailed August 1, 2006, the Examiner rejected claims 11 and 14-17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,896,618 to *Benoy et al.* (hereinafter, "*Benoy*"), and rejected claims 12-13 under 35 U.S.C. § 103(a) as being unpatentable over *Benoy* in view of U.S. Patent No. 6,116,402 to *Beach et al.* (hereinafter, "*Beach*")¹.

By this amendment, Applicants propose to cancel claims 13-15 and add claims 18-22 to more appropriately define their invention. No new matter is added by the proposed amendments. Claims 11, 12, and 16-22 remain pending upon entry of the claim amendments.

In light of the foregoing amendments and based on the arguments contained below, Applicants respectfully traverse the rejections of the claims under 35 U.S.C. §§ 102(e) and 103(a) and request allowance of claims 11, 12, and 16-22.

I. Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for the acknowledgment of foreign priority under 35 U.S.C. § 119, and additional acknowledgement of the receipt of the certified copies of the priority documents at item 12(a) on the Office Action Summary.

II. Claim Rejections under 35 U.S.C. § 102(e)

With respect to claims 14-15, the rejections under 35 U.S.C. § 102(e) in view of *Benoy* have been rendered moot by the proposed cancellation of those claims.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants respectfully traverse the rejections of claims 11, 16, and 17 under 35 U.S.C. § 102(e) as being anticipated by *Benoy*. A proper anticipation rejection requires each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131. The anticipation rejection set forth in the Office Action does not properly establish that each and every element of the amended claims is found in *Benoy*.

Benoy teaches a loyalty program registration method wherein the player enters personal identification information and loyalty program instrument information to a loyalty program registration interface. See *Benoy*, column 15, lines 52-56; column 16, lines 46-49. This information is sent to a player tracking server along with a registration request, whereupon the player tracking server generates a loyalty program account. See *Benoy*, column 5, lines 35-42. Specifically, *Benoy* teaches the data used to register a player as the player's personal information and pre-existing data **read from** the loyalty program instrument. See *Benoy*, column 15, lines 52-56; column 16, lines 46-49.

Benoy fails to teach or suggest, *inter alia*, a system comprising "ID generating means for generating an ID for uniquely identifying an external memory medium," "means for generating an access code corresponding to the ID and visually identifiable to a game player," and "data management means for managing the ID and the access code in association with one another," as recited in claim 11. Further, *Benoy* fails to teach or suggest "authenticating the game player in accordance with the access code,

and upon authentication of the game player, providing the game player with a network service,” as also recited in claim 11.

While the Office Action alleges that *Benoy* teaches “an ID generating means for generating an ID for uniquely identifying an external memory medium attached to the external medium (3: 3-8), where the ID can be recorded in a magnetic data recording area provided in the external memory medium (10: 38-59),” this is a mischaracterization of *Benoy*. OA, page 2. *Benoy* teaches a loyalty program instrument, such as a magnetic striped card, having a serial number or other identifying information. See *Benoy*, column 3, lines 3-10. *Benoy* discloses the information identifying the loyalty program instrument as **“obtained from the loyalty program instrument such as the serial number from the magnetic striped card.”** See *Benoy* at column 32, lines 39-40 (emphasis added). While *Benoy* does disclose the possibility of recording data onto the magnetic striped card, *Benoy* does not teach or suggest “ID generating means for generating an ID for uniquely identifying an external memory medium,” as recited in claim 11. Nor does *Benoy* teach or suggest an “ID recording means for recording the generated ID in a magnetic data recording area provided in the external memory medium,” as also recited in claim 11.

Although the Office Action states, “*Benoy* clearly teaches of obtaining a serial number or a bar code read from a loyalty program registration server (3: 3-12) and then registering this information on a ‘blank’ magnetic card (15: 25-55),” such a statement appears to be a misstatement of the teachings of *Benoy* and, in any event, is not applicable to the recited claim limitations. OA, page 5. As stated above, the serial number or bar code to which the Office Action refers “is **read from** a loyalty program

instrument....” Benoy, column 3, lines 5-6 (emphasis added). Furthermore, independent claim 11 recites, among other things, “ID generating means for **generating an ID** for uniquely identifying an external memory medium attached to the external interface” and “ID recording means for **recording the generated ID in a magnetic data recording area** provided in the external memory medium.” Contrary to the Examiner’s assertion, independent claim 11 does not recite “obtaining a serial number or a bar code read from a loyalty program registration server.”

In addition, the Office Action refers to “registering this information on a ‘blank’ magnetic card (15:25-55).” However, the cited text of *Benoy*, read in its entirety, discloses “‘point of play’ registration” where “[t]he registration request message contains the information necessary to register the player to the loyalty program such as the identification information entered by the player and **identification information from the loyalty point instrument** used in the registration process such as a serial number recorded from the magnetic striped card or other identification information recorded on the loyalty point instrument.” *Benoy*, column 16, lines 49-56 (emphasis added). Again, *Benoy* does not disclose “ID generating means for **generating an ID** for uniquely identifying an external memory medium attached to the external interface” and “ID recording means for **recording the generated ID in a magnetic data recording area** provided in the external memory medium,” as recited in independent claim 11.

Furthermore, the Office Action states, “[t]he gaming system further includes means for generating an access code corresponding to the ID (10:60-67).” OA, page 2. Additionally, the Office Action states “that registering a PIN number associated with the loyalty program device meets the limitation of generating an access code corresponding

to the ID.” OA, page 5. First, Applicants strongly disagree with this characterization. The text cited in the Office Action states, “requesting the game player to validate their identity by entering an identification code.” *Benoy*, column 10, lines 64-65. It is unclear how the Examiner has determined this statement meets the limitation, “means for generating an access code corresponding to the ID,” as recited in claim 11. Second, even if such a statement were correct, which Applicants do not concede, the Office Action fails to address the referenced claim limitation in its entirety. That is, claim 11 recites, “means for generating an access code corresponding to the ID **and visually identifiable to a player** (emphasis added).” Nowhere in *Benoy* is the PIN number visually identifiable to a player.

In addition, further limitations recited in claim 11 undermine the Examiner’s “conten[tion] that registering a PIN number associated with the loyalty program device meets the limitation of generating an access code corresponding to the ID.” OA, page 5. That is, claim 11 further recites, “printing means for printing the access code in a printing area of the external memory medium.” *Benoy* teaches only that the PIN number is variously input and, in one embodiment, “a PIN number may later be sent to the player.” See *Benoy*, column 10, lines 60-67, column 30, lines 8-10, column 33, lines 34-49, column 34, line 53.

Because *Benoy* at least fails to teach or suggest Applicants’ claimed ID generating means and means for generating an access code, *Benoy* also cannot teach or suggest Applicants’ claimed data management means for managing the ID and the access code in association with one another. Further, because *Benoy* fails to teach or suggest the access code, *Benoy* also cannot teach or suggest authenticating the game

player in accordance with the access code and, upon authentication of the game player, providing the game player with a network service, as also required by claim 11.

For at least the reasons stated above, Applicants submit that *Benoy* does not teach all the elements of Applicants' claim 11. Therefore, independent claim 11 as well as claims 16-17, which depend therefrom, are not anticipated by *Benoy*.

As stated above, Applicants propose to add new independent claims 18 and 22, as well as dependent claims 19-21. Among other limitations, claim 18 recites:

“[a] terminal device comprising:
operation means with which a player inputs a character message and identification information for identifying a player; and communication means for transmitting the character message and the identification information to the server device,

[an] arcade game machine comprising:
reading means for reading, via an interface, identification information for identifying a player recorded on an external memory medium; and communication means for transmitting the identification information read by the reading means to the server device, and

[a] server device comprising:
data management means for registering the character message and the identification information transmitted from the terminal device in association with each other in a database, and searching the database based on the identification information received from the arcade game machine; and communication means for transmitting a character message associated with the identification information specified by the search conducted by the data management means to the arcade game machine.”

Claim 22, although of different scope, recites similar limitations. Similarly to the arguments presented above with respect to independent claim 11, Applicants submit that *Benoy* does not teach all the elements of Applicants' proposed new independent

claims 18 and 22. Therefore, independent claims 18 and 22, as well as dependent claims 19-21, are allowable over *Benoy*.

IV. Claim Rejections Under 35 U.S.C. 103(a)

With respect to claim 13, the rejection under 35 U.S.C. § 103(a) over *Benoy* in view of *Beach* has been rendered moot by the proposed cancellation of that claim.

Applicants respectfully traverse the rejection of claim 12 under 35 U.S.C. 103(a) as being unpatentable over *Benoy* in view of *Beach*. In addition, Applicants respectfully submit that claim 12 and new claims 18-22 are allowable because neither *Benoy*, nor *Beach*, nor the combination thereof, establish a *prima facie* case of obviousness as required under 35 U.S.C. § 103(a).

“To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must ‘be found in the prior art, and not be based on applicant’s disclosure.’” M.P.E.P. § 2143 (8th ed. 2001).

A *prima facie* case of obviousness has not been established because, among other things, the cited references, taken alone or in combination, do not teach or suggests each and every feature of Applicants’ claims nor is there some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Applicants further submit that the Examiner’s stated suggestion or

motivation of obviousness is neither suggested by the references themselves nor in the knowledge generally available to one of ordinary skill in the art. For at least these reasons, Applicants respectfully request the allowance of claim 12, as well as new claims 18-22.

Beach appears to disclose a system which assists in detecting alteration of value documents or transmissions, such as a coin counter voucher. More particularly, *Beach* appears to teach a system and method for detecting voucher counterfeiting, alteration, duplication, fabrication, and the like by including encoded or encrypted voucher information. See *Beach*, column 9, lines 34-39.

Beach does not, *inter alia*, cure the deficiencies of *Benoy* set forth above and the failure of *Benoy* to teach or suggest a system comprising "ID generating means for generating an ID for uniquely identifying an external memory medium," "means for generating an access code corresponding to the ID and visually identifiable to a game player," and "data management means for managing the ID and the access code in association with one another, authenticating the game player in accordance with the access code, and upon authentication of the game player, providing the game player with a network service," as recited in independent claim 11, from which claim 12 depends.

While the Office Action, at pages 4-5, has pointed to "a system that encodes vouchers that are in the form of magnetic cards with time and machine location information" and alleges that this cures the deficiencies of *Benoy*, such is not the case. *Beach* teaches an encryption method wherein the time and machine location are part of the encryption scheme. See *Beach*, column 8, line 66 through column 9, line 32.

Beach does not teach or suggest generating either an ID or an access code, nor does *Beach* teach or suggest a data management means for managing an ID and an access code in association with one another, authenticating the game player in accordance with the access code, and upon authentication of the game player, providing the game player with a network service.

In addition to the failure of *Benoy* and *Beach* to teach or suggest all of these claim limitations, either alone or in combination, the Office Action's stated **motivation** is neither suggested by the references themselves nor in the knowledge generally available to one of ordinary skill in the art. The Office Action's assertion, at page 4, that it would have been obvious to one skilled in the art to "allow the tracking of timing as *Benoy* teaches to be used to define the serial numbers used to encode the player identification cards," misrepresents the teachings of *Benoy*. First, *Benoy* does not teach or suggest encoding as the Office Action asserts. Second, the "tracking of timing," which the Office Action states "[may be] used to define the serial numbers," is speculative at best. As stated repeatedly above, *Benoy* discloses the serial number are obtained from the cards. In addition, the cited passage of *Benoy* clearly states that "the player tracking unit 56 may poll ... for game play information such as ... the time when each game was initiated ... [and] the player tracking server 62 may use the game play information ... to generate player tracking points...." column 11, lines 9-17. Nowhere does *Benoy* teach or suggest that there is "tracking of timing" or that timing information is used "to define serial numbers," as the Office Action asserts. OA, page 4. Therefore, it would not have been obvious to use the encoding taught by *Beach* in the system and method disclosed by *Benoy*.

For at least the reasons stated above, Applicants submit that neither *Benoy*, nor *Beach*, nor any combination of the two, teach or suggest all the elements of Applicants' claim 11, nor is there any motivation to combine the references. Thus, Applicants respectfully request allowance of claim 12, at least due to its dependence from independent claim 11.

Similarly, Applicants submit that neither *Benoy*, nor *Beach*, nor any combination of the two, teach or suggest of the Applicants' independent claims 18 and 22, nor is there any combination to combine the references. Therefore, Applicants respectfully request allowance of independent claims 18 and 22, as well as dependent claims 19-21.

IV. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing pending claims 11, 12, and 16-22 in condition for allowance. Applicants submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of claims 11, 12, and 16-22. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: November 1, 2006